

Application No.: 10/606911Case No.: 55313US010**REMARKS**

Claims 1 to 26 are pending. Claims 1 to 11 have been withdrawn from consideration. Claims 12, 18, 20 and 21 are amended. No claims have been added.

§ 103 Rejections

Claims 12-14, 16, 18, 19, 21-23, 25 and 26 stand rejected under 35 USC § 103(a) as being unpatentable over Olsen (US 5,916,399) in view of Orensteen (US 5,706,133). Claims 17, 20, and 24 stand rejected under 35 USC § 103(a) as being unpatentable over Olsen (US 5,916,399) in view of Orensteen (US 5,706,133) further in view of Bacon et al (US 6,508,559). Applicants submit that these rejections are inappropriate and should be withdrawn.

The Amendments

Claims 12, 18, and 21 have been amended. Support for these amendments is present in the specification at, for example, page 20, lines 3-5 with respect to claim 12 and claim 20; page 23, lines 13-15 for claim 18; and page 20, line 3 through page 21, line 18 for claim 21.

These amendments each specify certain characteristics of the segment spacing or length that must be present during the practice of the process of the invention.

The Rejection of Claims 12-14, 16, 18, 19 21-23, 25 and 26

The Examiner's rejection is premised that it would be obvious to combine Olsen with Orensteen. Applicants reiterate the arguments that they raised in their last communication to the PTO. In addition to these arguments, Applicants submit that neither Olsen nor Orensteen discuss, and therefore cannot suggest, that the distance between the individual segments be such that they do not contact one another when the carrier is bent around a predetermined radius (claim 12); that the length of the individual segments be determined according to a formula that takes into account the extensional stiffness of the article, the bending rigidity of the article, a neutral axis a defined distance from the substrate to which the article is applied, and an anticipated bend radius of the substrate to which the article is applied (claim 18); and that the gap

Application No.: 10/606911

Case No.: 55313US010

between adjacent segments of retroreflective sheeting is determined according to a formula that is dependent upon the neutral axis, the length of the segment and the anticipated bend radius of the substrate to which the article is applied (claim 21).

Accordingly, the combination of references relied upon by the Examiner fails to support a *prima facie* case under 35 USC § 103(a) and the rejection of claims 12-14, 16, 18, 19, 21-23, 25 and 16 should be withdrawn.

The Rejection of Claims 17, 20 and 24

The Examiner's rejection is premised that it would be obvious to combine Olsen with Orensteen further in view of Bacon et al. Applicants reiterate the arguments that they raised in their last communication to the PTO and in the preceding paragraph. Applicants further point out that, with respect to claims 17 and 24 (dependent from claims 12 and 21 respectively), Bacon et al fails to overcome the underlying rejection. That is, it fails to discuss or suggest the size of the space between adjacent segments as required by these claims. Accordingly, the addition of Bacon et al to the rejection of these claims fails for this additional reason.

Therefor, the combination of references relied upon by the Examiner fails to support a *prima facie* case under 35 USC § 103(a) and the rejection of claims 17, 20, and 24 should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

Date*October 20, 2004*By: *James V. Lilly*James V. Lilly, Reg. No.: 27,817
Telephone No.: (651) 733-1543

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833